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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,775	07/29/2000	Koichi Kokusho	21778.04400	3839
7590	08/25/2005		EXAMINER	
Adam H Tachner Crosby Heafey Roach & May PO Box 7936 San Francisco, CA 94120-7936			ROBINSON, MYLES D	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 08/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/628,775 Examiner Myles D. Robinson	KOKUSHO, KOICHI Art Unit 2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 November 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 and 20-23 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 July 2000 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

TWYLER LAMB
PRIMARY EXAMINE

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>03/14/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PN11-217771 filed on 7/29/2000.

Information Disclosure Statement

2. The examiner has considered the references listed in the Information Disclosure Statement (IDS) submitted on 3/14/2002 (see attached PTO-1449).

Drawings

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference characters not mentioned in the description: references FOTO1, FOTO2, DOG1 and DOG2 in Figure 5.

4. Furthermore, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference 45 in Figure 3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Specification

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because the description of the disclosure is a run-on sentence that lacks both clarity and conciseness. Correction is required. See MPEP § 608.01(b).

Claim Objections

7. The following quotation of 37 CFR 1.75(a) is the basis of the objection:

- (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

8. **Claims 1 – 8, 20 – 23** are objected to under 37 CFR 1.75(a) as failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention or discovery. There is lack of antecedent basis for the each of these limitations within the following claims:

Claim 1 recites the limitations “the user” in line 4, “the print order receiving side” in line 7, “said identification data and order data” in line 8, “the basis of said order data” in line 12, and “the basis of said identification data” in line 15 of this claim. The examiner suggests replacing with the following: “~~a the user~~” in line 4, “~~a the print order receiving side~~” in line 7, “~~an order data and said identification data and order data~~” in line 8, “~~based upon the basis of said order data~~” in line 12, and “~~based upon the basis of said identification data~~” in line 15. All claims dependent upon these claims suffer the same deficiency and, therefore, are objected to as well.

Claim 2 recites the limitations “the charge” and “the basis of said order data” in line 3 and “the basis of the result” in line 5 of this claim. The examiner suggests replacing with the following: “~~a the charge~~” and “~~based upon the basis of said order data~~” in line 3 and “~~based upon the basis of the result~~” in line 5.

Claim 4 recites the limitations “the charge” and “the basis of said order data” in line 3 and “the basis of the result” in line 5 of this claim.

Claim 5 recites the limitations “the user side” in line 3, “the print order receiving side” in line 6, “said identification data and order data” in line 7, “the basis of said order data” in line 10, and “the basis of said supplied identification data” in line 12 of this claim. All claims dependent upon these claims suffer the same deficiency and, therefore, are objected to as well.

Claim 6 recites the limitations “the charge” in line 3, “the basis of said order data” in line 4 and “the basis of the result” in line 5 of this claim.

Claim 8 recites the limitations “the charge” in line 3, “the basis of said order data” in line 4 and “the basis of the result” in line 5 of this claim.

Claim 20 recites the limitations “said identification data and order data” in line 8, “the basis of said received order data” in line 10 and “the basis of said received identification data” in line 12 of this claim. All claims dependent upon these claims suffer the same deficiency and, therefore, are objected to as well.

Claim 21 recites the limitations “the charge” and “the basis of said order data” in line 3 and “the basis of the result” in line 5 of this claim. All claims dependent upon these claims suffer the same deficiency and, therefore, are objected to as well.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 1 – 8, 20 – 23** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations "the orderer" in line 14 of this claim. There is insufficient antecedent basis for this limitation in the claim.

Furthermore, claim 1 recites the limitations of "a registration means for registering the user" in line 4 followed by the recitation of "said registered users" in line 15 of this claim. The applicant has failed to particularly point out and distinctly claim whether the system claimed requires a singular user or a plurality of users. All claims dependent upon these claims suffer the same deficiency and, therefore, are rejected to as well.

In search of prior art, the examiner assumes that the orderer is synonymous with the user and that the system includes a plurality of users although the natures of its meaning are ambiguous.

Claims 2 and 4 recites the limitation "the stated accounting processing" in line 5 of both of these claims. There is insufficient antecedent basis for this limitation in these claims.

In search of prior art, the examiner assumes that the stated accounting processing is synonymous with the accounting means although the nature of its meaning is ambiguous.

Claim 5 recites the limitations "said user" in line 4, "the orderer" in line 10, "said supplied identification data" in line 11 and "the resulted print" in line 11 of this claim. There is insufficient antecedent basis for each of these limitations in the claim.

Furthermore, claim 5 recites the limitations of "registering said user" in line 4 followed by the recitation of "said registered users" in line 11 of this claim. The applicant has failed to particularly point out and distinctly claim whether the system claimed requires a singular user or a plurality of users. All claims dependent upon these claims suffer the same deficiency and, therefore, are rejected to as well.

In search of prior art, the examiner assumes that the orderer is synonymous with the user, that the supplied identification data is synonymous with the transmitted identification data, and that the resulted print is synonymous with the picture although the nature of its meanings are ambiguous.

Claim 6 recites the limitations "the third step" in line 3 and "the stated accounting processing" in line 4 of this claim. There is insufficient antecedent basis for each of these limitations in the claim.

In search of prior art, the examiner assumes that the third step is referring to the third paragraph of claim 5 although the nature of its meaning is ambiguous.

Claim 7 recites the limitations "the first step" in line 3 and "the third step" in line 6 of this claim. There is insufficient antecedent basis for each of these limitations in the claim. All claims dependent upon these claims suffer the same deficiency and, therefore, are rejected to as well.

In search of prior art, the examiner assumes that the first step is referring to the first paragraph of claim 5 and that the third step is referring to the third paragraph of claim 5 although the nature of its meanings are ambiguous.

Claim 8 recites the limitation "the third step" in line 3 and "the accounting processing" in line 4 of this claim. There is insufficient antecedent basis for each of these limitations in the claim.

In search of prior art, the examiner assumes that the third step is referring to the third paragraph of claim 7 although the nature of its meaning is ambiguous.

Claim 20 recites the limitation "the orderer" in line 12. There is insufficient antecedent basis for this limitation in the claim.

Furthermore, claim 20 recites the limitations of "a registration means side which registers a user" in line 5 followed by the recitation of "said registered users" in line 13 of this claim. The applicant has failed to particularly point out and distinctly claim whether the system claimed requires a singular user or a plurality of users. All claims dependent upon these claims suffer the same deficiency and, therefore, are rejected to as well.

In search of prior art, the examiner assumes that the orderer is synonymous with the user and that the system includes a plurality of users although the natures of its meaning are ambiguous.

Claim 21 recites the limitation "the stated accounting processing" in line 4. There is insufficient antecedent basis for this limitation in the claim. All claims dependent upon these claims suffer the same deficiency and, therefore, are rejected to as well.

In search of prior art, the examiner assumes that the stated accounting processing is synonymous with the accounting means although the nature of its meaning is ambiguous.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. **Claims 1, 2, 5, 6, 20 – 23** are rejected under 35 U.S.C. 102(e) as being anticipated by **Enomoto et al.** (U.S. Patent No. 5,974,401).

Referring to **claim 1**, Enomoto discloses a print order/delivery system (column 1, lines 7 – 11) comprising a storage means for unique identification data which has been previously assigned (see Fig. 3), a registration means for registering for registering the user in such a way as to associate him with said identification data (column 4, lines 39 – 51, column 6, lines 10 – 22 and column 7, lines 57 – 59), an ordering means (personal computer 11 in Fig. 1) for transmitting pictorial data to the print order receiving side (photofinisher 12 in Fig. 1) along with said identification data and order data (column 3, lines 40 – 51, column 3, line 60 – column 4, line 1, column 6, lines 10 – 18, 45 – 49, and column 7, lines 14 – 21), a printing means (printers 15, 16, and 17 in Fig. 1), which is

placed on said print order receiving side, for printing a picture based on said pictorial data which is transmitted from said ordering means (column 7, lines 22 – 26 and column 8, lines 53 – 59), on the basis of said order data (column 6, line 55 – column 7, line 3), and a user management means, which is placed on said print order receiving side, for recognizing the orderer out of said registered users (column 6, line 55 – 62 refers to a plurality of users), on the basis of said identification data which is transmitted from said ordering means (column 4, lines 39 – 51, column 6, lines 10 – 22 and column 8, lines 41 – 52).

Referring to **claim 2**, Enomoto discloses the system further comprising an accounting means for calculating the charge on the basis of said order data (column 6, line 55 – column 7, line 3), and for performing the stated accounting processing on the basis of the result of the calculation (column 4, lines 32 – 38, column 5, lines 53 – 56, column 7, lines 48 – 53, and column 8, lines 13 – 18).

Referring to **claim 5**, Enomoto discloses a print order/delivery method (column 1, lines 7 – 11) comprising storing a previously assigned unique identification data (see Fig. 3, column 4, lines 39 – 51 column 6, lines 10 – 22 and column 7, lines 57 – 59) which is performed on the user side (reference 10 in Fig. 1), and registering said user in such a way as to associate him with said identification data (column 4, lines 39 – 51, column 6, lines 10 – 22 and column 7, lines 57 – 59), transmitting pictorial data to the print order receiving side along with said identification and order data (column 6, lines 46 – 50), printing a picture based on said supplied pictorial data on the basis of said order data (column 6, line 55 – column 7, line 3), recognizing the orderer out of said

registered users on the basis of said supplied identification data (column 4, lines 39 – 51, column 6, lines 10 – 22 and column 8, lines 41 – 52), and delivering the resulted print of said picture to the very orderer which, are performed on said print order receiving side (column 4, lines 32 – 38).

Referring to **claim 6**, Enomoto discloses the method wherein in the third step, the charge of said print is calculated on the basis of said order data (column 6, line 55 – column 7, line 3), and the stated accounting processing is performed on the basis of the result of the very calculation (column 4, lines 32 – 38, column 5, lines 53 – 56, column 7, lines 48 – 53, and column 8, lines 13 – 18).

Referring to **claim 20**, Enomoto discloses a printing system (column 1, lines 7 – 11) for printing a picture taken by a digital camera (reference 21 in Fig. 1) having identification data (column 4, lines 39 – 51, column 6, lines 10 – 22 and column 8, lines 41 – 52) previously assigned comprising a receiving means (column 4, lines 56 – 65) for receiving identification data and user information (column 4, lines 39 – 40, column 7, lines 57 – 59) transmitted from a registration means side which registers a user associated with said identification data or receiving pictorial data of said picture, said identification data and order data transmitted from a print ordering side (user side 10 in Fig. 1, column 4, lines 39 – 51, column 6, lines 10 – 22 and column 8, lines 41 – 52), a printing means (printers 15, 16 and 17 in Fig. 1) for printing a picture based on said pictorial data on the basis of said received order data (column 6, line 55 – column 7, line 3, column 7, lines 22 – 26 and column 8, lines 53 – 59), and a user management means for recognizing the orderer out of said registered users on the basis of said received

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identification data (column 4, lines 39 – 51, column 6, lines 10 – 22 and column 8, lines 41 – 52).

Referring to **claim 21**, Enomoto discloses the system further comprising an accounting means for calculating the charge on the basis of said order data (column 6, line 55 – column 7, line 3) and performing the stated accounting processing on the basis of the result of said calculation (column 4, lines 32 – 38, column 5, lines 53 – 56, column 7, lines 48 – 53, and column 8, lines 13 – 18).

Referring to both **claims 22 and 23**, Enomoto discloses the system further wherein said user management means is provided with a database (reference 24 in Fig. 1) containing said user information associated with said identification data (see Fig. 3, column 4, lines 56 – 65).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. **Claims 3, 4, 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Enomoto et al.** (U.S. Patent 5,974,401) in view of **Parulski et al.** (U.S. Patent 6,573,927 B2).

Referring to **claims 3 and 4**, Enomoto discloses the print order/delivery system comprising storing means, registration means, ordering means, printing means, user

management means, and accounting means as discussed above in claims 1 and 2, respectively, but does not explicitly disclose the ordering means taking pictorial data and identification from a digital camera having storing means and recording medium and transmitting pictorial data, order data, and identification data to print order receiving side.

Parulski discloses a digital print order and delivery method and system wherein a storing means (image DRAM memory 32 and removable memory card 36 in Fig. 1, column 3, lines 16 – 29) placed on a digital camera (reference 12 in Fig. 1) which takes in a picture electronically, and an ordering means (column 4, lines 36 – 41) that takes said pictorial data and said identification data out of said digital camera or a recording medium (removable memory card 36 in Fig. 1) which has been put on the very digital camera and transmits the pictorial data and the identification data (column 3, lines 39 – 44, column 6, lines 26 – 53) to said print order receiving side (service provider 14 in Fig. 1) along with said order data (column 2, lines 12 – 18, column 2, line 53 – column 3, line 4). Furthermore, it is inherent and well known among those of ordinary skill in the art that a digital camera takes in a picture electronically.

Enomoto and Parulski are combinable because they are both from the same field of endeavor, being digital photography and print ordering systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include a digital camera with storage means for pictorial data and identification data within the print order/delivery system. The suggestion/motivation for doing so would have been

the added value of convenience and ease of use for customers ordering and delivering prints, as suggested by Parulski (column 1, line 60 – column 2, line 27).

Referring to claims 7 and 8, Enomoto discloses the print order/delivery method comprising steps of storing identification data, registering user, transmitting various data, printing picture, recognizing orderer, delivering print to orderer, calculating charge, and performing accounting processing as discussed above in claims 5 and 6, respectively, but does not explicitly disclose that the identification data is stored in a digital camera, the pictorial data and identification data are taken from the digital camera or a recording medium which has been put on the digital camera, and the pictorial data, order data, and identification data are transmitted to the print order receiving side.

Parulski discloses a digital print order and delivery system and method wherein a said identification data (column 6, lines 26 – 53) is stored in a digital camera (reference 12 in Fig. 1), which takes in a picture electronically (column 3, lines 39 – 44), and said pictorial data and said identification data are taken out of said digital camera or recording medium (removable memory card 36 in Fig. 1) which has been put on the digital camera, and the very pictorial data and identification data are transmitted to said print order receiving side (service provider 14 in Fig. 1) along with said order data (column 2, lines 12 – 18, column 2, line 53 – column 3, line 4). Furthermore, it is inherent and well known among those of ordinary skill in the art that a digital camera takes in a picture electronically.

Enomoto and Parulski are combinable because they are both from the same field of endeavor, being digital photography and print ordering systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include a digital camera with storage means for pictorial data and identification data within the print order/delivery system. The suggestion/motivation for doing so would have been the added value of convenience and ease of use for customers ordering and delivering prints, as suggested by Parulski (column 1, line 60 – column 2, line 27).

Citation of Pertinent Art

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Squilla et al. (U.S. Patent No. 6,396,537 B1) discloses a photographic system for enabling interactive communication between a camera and an attraction site.

Fredlund et al. (U.S. Patent No. 5,666,215) discloses a system and method for remotely selecting photographic images.

Shiota et al. (U.S. Patent No. 6,157,459) discloses a method and apparatus for outputting picture image data.

Maurinus et al. (U.S. Patent No. 5,606,365) discloses an interactive camera for network processing of captured images.

Gotanda et al. (U.S. Patent No. 6,707,570) discloses an image printing system and method of controlling operation of same.

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Enomoto et al. (Japanese Patent No. 10-078618) discloses a method and system for ordering and delivering digital print.

Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571) 272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MYZER LAMB
PRIMARY EXAMINER

MDR

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